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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,333	01/29/2001	James A. Barnard	82007RLO	8676

7590 07/27/2004  
Patent Legal Staff  
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EXAMINER

HOFFMAN, BRANDON S

ART UNIT PAPER NUMBER

2136

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/772,333

Applicant(s)

BARNARD ET AL.

Examiner

Brandon Hoffman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:
  - On page 12, line 21, reference number 96 from figure 5 is missing.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moribe et al. (U.S. Patent No. 5,818,812) in view of Kajiyama et al. (U.S. Patent No. 6,108,296).

Regarding claims 1 and 2, Moribe et al. teaches a method for copy-protecting information recorded on an optical disc/a copy-protected optical disc, comprising the steps of:

- Forming a number of optical discs which have the preformed ID duplicated from the master disc (col. 6, lines 22-46);
  - Writing a unique identification number onto such optical disc (fig. 1, ref. num 4 and col. 6, lines 5-9); and
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- Writing an encrypted program onto the optical disc wherein the encryption of such program is based upon the unique ID (fig. 6 and col. 7, lines 10-23).

Moribe et al. does not teach forming a master disc that includes a preformed ID, and the encryption of the program is based upon the preformed ID.

Kajiyama et al. teaches forming a master disc that includes a preformed ID (fig. 10, 'VENDOR CODE' and col. 7, lines 52-61); and the encryption of the program is based upon the preformed ID (col. 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine forming a master disc that includes a preformed ID and the encryption of the program is based upon the preformed ID, as taught by Kajiyama et al., with the method of Moribe et al. It would have been obvious for such modifications because the copy protect information can vary with each disc, thus improving the copy protect ability (see col. 7, lines 59-61 of Kajiyama et al.).

Regarding claim 3, the combination of Moribe et al. in view of Kajiyama et al. teaches further including the step of reading and decrypting the encrypted program using the preformed ID and the unique ID read from the disc (see col. 7, lines 24-66 of Moribe et al.).

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Regarding claim 4, the combination of Moribe et al. in view of Kajiyama et al. teaches in which the unique ID is recorded at one or more known absolute sector addresses on the disc (see fig. 1, ref. num 4 and col. 6, lines 5-12 of Moribe et al.).

Regarding claim 5, the combination of Moribe et al. in view of Kajiyama et al. teaches in which the unique ID is recorded into the second session (see fig. 1, ref. num 4 and col. 6, lines 5-9 of Moribe et al.).

Regarding claim 6, the combination of Moribe et al. in view of Kajiyama et al. teaches in which the disc further includes a recordable area (see fig. 1, ref. num 3 and col. 6, lines 4-5 of Moribe et al.).

Regarding claim 7, the combination of Moribe et al. in view of Kajiyama et al. teaches in which supplied software and/or data is also pressed into the first session (see fig. 1, ref. num 1 and col. 5, line 64 through col. 6, line 1 of Moribe et al.).

Regarding claim 8, the combination of Moribe et al. in view of Kajiyama et al. teaches a copy-protection system including a computer, the copy-protected optical disc of claim 1, and an encrypting program capable of reading the preformed ID and the unique ID from the copy-protected optical disc of claim 1 and encrypting a customer program using them (see fig. 6 and col. 7, lines 10-23 of Moribe et al.).

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Regarding claim 9, the combination of Moribe et al. in view of Kajiyama et al. teaches in which an encrypting program is pressed onto the optical disc (see col. 6, lines 23-39 of Kajiyama et al.).

Regarding claim 10, the combination of Moribe et al. in view of Kajiyama et al. teaches in which the encrypting program is located on another computer system or on a network (see col. 7, lines 10-23 of Moribe et al., the program that performs the steps to encrypt data is located on a different computer than the computer that will read the encrypted program in hopes to decrypt the data).

Regarding claim 13, the combination of Moribe et al. in view of Kajiyama et al. teaches in which valid values of the unique ID correspond to only a small part of the range of possible numbers (see col. 6, lines 5-9 of Moribe et al., any amount of valid values will in essence be only a small part of a range of possible numbers because there are an infinite amount of number possibilities.).

Regarding claim 11, Moribe et al. teaches a method of copy protection using a Programmable CD-ROM and a decrypting program, which includes the steps of:

- Reading the unique ID of the Programmable CD-ROM (fig. 7A, ref. num S14 and fig. 7B, ref. num S22 and col. 7, lines 31-36 and 49-58);
  - Using the decryption key to decrypt the original executable file (fig. 7A, ref. num S19 and col. 7, lines 43-46);
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- Placing the original executable into the computer's RAM memory and allowing it to execute and removing the original executable from the computer's memory and storage upon completion of the executable (Official Notice is taken for placing and executable into RAM for operation and then removing the executable after operation is complete. This is well known and performed when an optical medium is placed in the reading unit of a computer. RAM is a temporary storage for applications to run in which said applications are removed after their use).

Moribe et al. does not teach reading the preformed ID and combining the preformed ID and the unique ID to form a decryption key.

Kajiyama et al. teaches reading the preformed ID and combining the preformed ID and the unique ID to form a decryption key (col. 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine reading the preformed ID and combining the preformed ID and the unique ID to form a decryption key, as taught by Kajiyama et al., with the method of Moribe et al. It would have been obvious for such modifications because the copy protect information can vary with each disc, thus improving the copy protect ability (see col. 7, lines 59-61 of Kajiyama et al.).

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Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moribe et al. (U.S. Patent No. 5,818,812) in view of Kajiyama et al. (U.S. Patent No. 6,108,296), and further in view of Ogawa (U.S. Patent No. 6,704,269).

Regarding claim 12, the combination of Moribe et al. in view of Kajiyama et al. teaches all the limitations of claim 11, above. However, the combination of Moribe et al. in view of Kajiyama et al. does not teach with the decrypting program reading the preformed ID from the ATIP signal.

Ogawa teaches with the decrypting program reading the preformed ID from the ATIP signal (col. 9, line 67 through col. 10, line 13).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the decrypting program reading the preformed ID from the ATIP signal, as taught by Ogawa, with the method of Moribe et al./Kajiyama et al. It would have been obvious for such modifications because the ATIP signal already exists so by placing the preformed ID in an already existing signal, no extra data is needed.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moribe et al. (U.S. Patent No. 5,818,812) in view of Ogawa (U.S. Patent No. 6,704,269).

Regarding claim 14, Moribe et al. teaches a uniquely identified optical disc, comprising:

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- A unique ID which is written to the main channel data at a known absolute sector address on the optical disc (fig. 1, ref. num 4 and col. 6, lines 5-9).

Moribe et al. does not teach a preformed ID which is formed in the ATIP signal.

Ogawa teaches a preformed ID which is formed in the ATIP signal (col. 9, line 67 through col. 10, line 13).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a preformed ID which is formed in the ATIP signal, as taught by Ogawa, with the method of Moribe et al. It would have been obvious for such modifications because the ATIP signal already exists so by placing the preformed ID in an already existing signal, no extra data is needed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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